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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/938,909	09/26/97	LAUNDER	B 30496.00.017
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PM82/0909

EXAMINER

BATSON, V

ART UNIT

PAPER NUMBER

3671

15

DATE MAILED:

09/09/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
08/938,909

Applicant(s)

LAUNDER ET AL.

Examiner  
VICTOR BATSON

Group Art Unit  
3671



☒ Responsive to communication(s) filed on Aug 23, 1999

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1, 2, 4-9, 11-15, 17-32, and 64-78 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 1, 2, 4-9, 11-13, 31, 32, and 64-78 is/are allowed.

☒ Claim(s) 14, 15, and 17-30 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

### **Response to Amendment**

1. The amendment filed 8/23/99 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the assembly having **at least three generally parallel stabilizing support surfaces with each stabilizing support surface being at least partially surrounded by a generally vertical wall extending normal to and between a stabilizing support surface, and wherein the generally vertical wall of each stabilizing support surface extends at least partially in a fore-and-aft direction and on opposite lateral sides of said vertical axis,**(claim 29). The specification discloses two stabilizing support surfaces having generally vertical walls, but not three support surfaces having generally vertical walls.

Applicant is required to cancel the new matter in the reply to this Office action.

### **Claim Rejections - 35 USC § 102**

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this

country, more than one year prior to the date of application for patent in the United States.

3. Claims 14,15,18-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Cornelius (5,272,824).

Cornelius discloses an excavation tooth assembly comprising an adapter 14 having a horizontal land section through which a bore 38 defining a first generally vertical axis extends, wherein the horizontal land section has a generally semicircular shape and includes a generally vertical wall as shown in figure 1.

Cornelius further discloses an excavating tooth having a hollow mounting end defining a cavity, with a substantially horizontal transmitting section through which a hole extends, with the transmitting section being configured to mate with the land section of the adapter in abutting relationship, with Cornelius also disclosing a fastener 16 for securing the excavating tooth to the adapter.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cornelius (5,272,824).

Cornelius discloses an excavating tooth assembly as

described previously, but lacks the recess being formed in the excavating tooth. Cornelius discloses the protruding section being located on the tooth with the recess formed on the adapter.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to locate the recess on the tooth and the protrusion on the adapter, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167.

#### ***Allowable Subject Matter***

6. Claims 1,2,4-9,11-13,31,32,64-78 are allowed.

#### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art of record discloses various excavating tooth assemblies.

#### ***Response to Arguments***


8. Applicant's arguments with respect to claims 14,15,17-30 have been considered but are moot in view of the new ground(s) of rejection. The verified statement of Brian L. Launder has been considered and the petition to correct inventorship has been granted as described in the attached decision on petition.

Inquiries

9. Any inquiry concerning this communication should be directed to Examiner Victor Batson whose telephone number is (703) 305-6356. The examiner can be normally reached Monday through Friday (except Wednesday) from 7:00 am to 5:00 pm, Eastern Standard Time.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Will, can be reached on (703) 308-3870. The fax phone number for this Group is (703) 305-7687.

September 7, 1999

  
Victor Batson  
Primary Examiner  
Art Unit 3671